

Attorney Docket No. 024827-2701

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 11, 12 and 41 have been cancelled.

Claims 1, 5, 8, 19, 20, 25, 28, 29, 32, 43, and 44 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-10, 13-40 and 42-50 are now pending in this application.

The Examiner objected claims 1, 5, 9, 19-20, 25, 28-29, 33, 43, and 44 due to various "informalities." Applicant has amended the claims generally in accordance with the Examiner's suggestion. As such, Applicant respectfully requests the objection be withdrawn.

The Examiner rejected claims 1-10, 14-24, and 39-47 under 35 U.S.C. §103(a) as being unpatentable over U.S. Application Publication No. 2002/0089968, in the name of Johansson in view of U.S. Application Publication No. 2004/0136358, in the name of Hind. The Examiner rejected claims 13 and 25-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Johansson in view of U.S. Application Publication No. 205/0050148 A1, in the name of Mohammadioun. The Examiner rejected claims 48-50 under 35 U.S.C. §103 (a) as being unpatentable over Johansson combined with Hind in view of U.S. Patent No. 6,866,587 B1, in the name of Lane.

The Johansson reference primarily discusses determining the radio transferring capabilities of a receiving GPRS station before sending packet data to the GPRS station so that

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the data can be tailored to the specific receiving capabilities of the receiver, such as multi-slot capability, quality of service of provided by the network to the receiver, radio priority allocated to the receiver, etc. As previously argued by the Applicant, the Johansson et al reference deals exclusively with an initial setup situation and is completely silent regarding activities that occur after a connection has been established. The Examiner admits that Johansson reference does not disclose that the client device sends a new packet switched registration message whenever the packet switched data network assigns the client device a new packet switched network address. That is because the Johansson reference is not concerned with the problems solved by the subject application, namely obtaining, tracking and maintaining the packet switched network address of client devices capable of packet switched communication with the network. The Johansson reference is not properly combinable with the other cited references as neither it nor the other cited references even recognize the problem solved by the subject application. As such, the cited references lack any teaching or motivation which would enable a person skilled in the art to build a communication system or client device or use the methods disclosed and claimed in the subject application.

Furthermore, even if the references could be combined, there is absolutely no teaching or suggestion to do so provided by the cited references. When specific claim limitations are missing, the examiner is required to explain why or how the prior art or the general knowledge of the art provides a teaching, suggestion or motivation to modify the prior art to produce the claimed structure. *In re Gal*, 25 USPT2d 1076, 1079 (Fed.Cir. 1992). Furthermore, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 15 USPQ2d 1566, 1568 (Fed.Cir. 1990).

In this case, the prior art does not disclose or suggest a client device configured to send a packet switched network address whenever the packet switched data network assigns the client device a new packet switched network address. The only possible suggestion or motivation to do so comes from the applicant's own disclosure. It is improper for the examiner to use hindsight

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reconstruction wherein the examiner uses the applicant's own disclosure as a blueprint to reconstruct the claimed invention out of unrelated isolated teaching in the prior art. *In re Oetiker*, 24 USPQ2d 1443, 1446 (Fed.Cir. 1992). As such, the applicant respectfully requests the examiner withdraw the outstanding rejection of the pending claims.

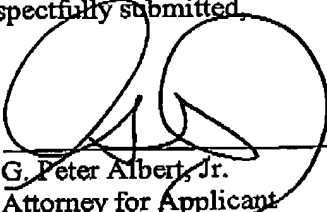
Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

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